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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/853,323 05/08/97 TALIEH

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QM12/0921

EXAMINER

NGUYEN, G

ART UNIT

PAPER NUMBER

3723

16

DATE MAILED:

09/21/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/853,323**

Applicant(s)  
**Talieh et al.**

Examiner  
**Nguyen**

Group Art Unit  
**3723**



☒ Responsive to communication(s) filed on Mar 31, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 32, 34, and 36-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 32, 34, and 36-43 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on July 26, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/853,323 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32, 34, 36-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32, 34, and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbard et al.'844 in view of McGarvey'765 and Kircher et al.'743.

With reference to Figs. 1-3, column 5, line 45 bridging to column 6, line 62, column 15, line 45 bridging to column 16, line 44, Hibbard discloses the claimed invention except for the backing layer being formed of metal.

McGarvey discloses an abrasive belt. With reference to column 2, lines 12-22, McGarvey discloses that the backing material may consist of any conventional backing used in abrasive coated products. The backing material (1) may be glue, resin, or varnish, the choice of which depends on the desired flexibility and stretch, resistance to heat and other factors which are determined by the intended use of the finished article and production requirements.

Kircher et al.'743 discloses an abrasive coating article. With reference to Figs. 1-3, the polishing pad 2 is attached to a metal backing 2, such as steel, brass, copper, or aluminum. The metal backing provides flexibility, resiliency, and strength, as well as having the property of preventing warpage in the finished article.

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the belt being formed of metal since it was known in the art as taught

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by McGarvey and Kircher that the choice of the metal backing material would provide the desired flexibility, resistance to heat, and strength to prevent warpage in the finished article.

*Response to Arguments*

6. Applicant's arguments with respect to claims 32, 34, and 36-43 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nguyen whose telephone number is (703) 308-0163. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Scherbel, can be reached at (703) 308-1272. The fax number for this Group is (703) 305-3579.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 308-1148.

  
George Nguyen

9/20/99